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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,425	09/07/2004	Achim Weber	P/ 2107-253	9293

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EXAMINER	
YU, MELANIE J	

ART UNIT	PAPER NUMBER
1641	

MAIL DATE	DELIVERY MODE
04/29/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/500,425	WEBER ET AL.	
	Examiner	Art Unit	
	MELANIE YU	1641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 January 2002*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7,11-65,78,80,82,84,86,88,90 and 92-96* is/are pending in the application.

4a) Of the above claim(s) *See Continuation Sheet* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,6,7,13-22,24-26,29-31,35-46 and 90* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *28 June 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Continuation of Disposition of Claims: Claims withdrawn from consideration are 5,11,12,23,27,28,32-34,47-65,78,80,82,84,86,88 and 92-96.

DETAILED ACTION

1. Applicant's arguments filed 29 January 2010 have been entered and considered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. Claims 1-4, 6, 7, 13-17, 19-22, 24-26, 29-31, 35-46 and 90 are rejected under 35 U.S.C. 103(a) as being obvious over Mirkin et al. (US 2002/0127574) in view of Kotov (US 7,045,087) further in view of Lynn et al. (US 7,112,361).

Regarding claims 1 and 90, Mirkin et al. teach an element comprising a carrier with a surface (transparent substrate, Fig. 13B) and at least one microstructure on the carrier surface (single microstructure shown, Fig. 13B, bottom two figures), wherein the microstructure consists of individual components in the form of nanoparticles (circular elements are gold nanoparticles, Fig. 13B), which have molecule specific detection sites with one or more first functional groups (DNA absorbed onto particles, Fig. 13B) to

which biologically functioning or active molecules bind to the first functional groups can be bound in a directional manner and thus make possible the addressability of the microstructure (analyte DNA strand hybridized to first functional group, Fig. 13B), and wherein between the surface of the carrier and the microstructure at least one layer of a bonding agent that is a self assembled monolayer based on thiol is provided to ensure permanent adherence of the nanoparticles (nanoparticles bonded to the surface through thiol monolayer, Fig. 13B).

Mirkin fails to teach the bonding agent being a plasma layer with charged chemically reactive groups.

Kotov teaches a functional element comprising: a carrier with a surface (col. 5, lines 18-27) and at least one microstructure on the carrier surface, where the microstructure consists of individual components in the form of nanoparticles (second solution deposits nanoparticles on the substrate, col. 5, lines 42-48) and a bonding agent between the surface of the carrier and the nanoparticles, wherein the bonding agent is a polyelectrolyte layer with charged groups (first solution deposits positively charged polyelectrolyte layer on the substrate, which is a polyelectrolyte layer, and is between the substrate and the nanoparticles, col. 5, lines 32-41; polyelectrolyte layer has chemically charged reactive groups, col. 3, lines 49-59), and is provided to ensure permanent adherence of the nanoparticles (nanoparticles are adsorbed onto the surface and are therefore permanently adhered, col. 3, lines 31-41; film of plasma and nanoparticles remains intact as a unitary structure, col. 2, lines 13-15), in order to provide a freestanding film that permits incorporation of biological compounds.

Lynn et al. teach that a polyelectrolyte layer attached to a substrate through a plasma layer, wherein the polyelectrolyte layer has charged groups, thereby creating a plasma layer with charged groups, wherein the two layers, the plasma layer and the polyelectrolyte layer form a single bonding layer as recited by the claims, wherein the plasma layer is the plasma and the polyelectrolyte are the charged groups (col. 2, line 58-col. 3, line 15 and col. 8, lines 5-25), in order to provide a substrate having polyelectrolyte layers with alternating charge.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include in the element of Mirkin et al., a bonding agent of a polyelectrolyte layer with charged chemically reactive groups between the microstructure and the carrier surface as taught by Kotov, in order to take advantage of overcompensation of surface charges and provide increased adsorption of nanoparticles on the substrate. It would have further been obvious to one having ordinary skill in the art at the time the invention was made to attach the polyelectrolyte to the substrate of Mirkin et al. in view of Kotov, using a plasma layer as taught by Lynn et al, in order to provide a uniform surface layer for layer-by-layer assembly of polyelectrolytes.

Although Lynn et al. does not specifically recite a "bonding layer" when combined with Kotov, the combination of references teaches the components required of a bonding layer as recited by the instant claims. The plasma taught by Lynn et al. is the plasma component of the bonding layer and the polyelectrolyte taught by Lynn et al. and Kotov is the charged groups of the bonding layer. Therefore the combination of

references teaches a bonding layer as recited by the instant claims having plasma directly on the substrate and a polyelectrolyte attached to the plasma therefore giving the plasma charged groups. When combined with Kotov the nanoparticles are then attached to the charged groups (polyelectrolyte) portion of the binding layer.

Regarding claims 2-4, Mirkin et al. teach the microstructure having a diameter of 375 μm on the planar, glass slides (surface is a glass slide, which is planar, par. 133; diameter of spot a length parameter and is within the recited range of 10 nm to 999 μm, par. 383).

With respect to claim 6, Mirkin et al. teach the surface of the carrier having a layer of a chemical compound that prevents nonspecific attachment of biological molecules to the carrier surface (par. 372).

Regarding claim 7, Mirkin et al. teach a layer of a bonding agent arranged between the carrier surface and the microstructure (nanoparticles bonded to the surface through thiol monolayer, Fig. 13B).

With respect to claims 13-15, Mirkin et al. teach the nanoparticles comprise a core and a surface that has the molecule specific recognition sites covalently bound to the nanoparticles (oligonucleotides with a functional group that binds to the nanoparticles is bound to the nanoparticles, par. 61) and biologically active molecules bound to the molecule-specific recognition sites (oligonucleotides that are recognition oligonucleotides are attached to the biologically active molecules on the nanoparticles, par. 62).

Regarding claims 16 and 17, Mirkin et al. teach that the molecules are bound while preserving their biological activity (par. 7 and 62) and the bound molecules are nucleic acids (par. 7).

With respect to claims 19 and 20, Mirkin et al. teach the molecule specific recognition sites comprising one or more first functional groups and the bound molecules comprise complementary second functional groups that bind the first functional groups (par. 173) and the function group being an amino or aldehyde (par. 180).

Regarding claims 21 and 41-46 are drawn to methods of making the functional element and does not provide additional structural limitations. Mirkin et al. teach the limitations recited in claim 1 and therefore has the same structure as a functional element produced by the methods recited in claims 21 and 41-46.

With respect to claims 22, 24-26 and 29, Mirkin et al. teach the first functional groups bound to the surface of the nanoparticles via a spacer (par. 242) and the core of the nanoparticles being polystyrene (par. 180) and having a diameter of 5-150 nm (par. 107), which falls within the recited range of 5 to 500 nm.

Regarding claims 30, 31 and 35, Mirkin et al. teach the core or the bound molecule having an anchored fluorescence marker (oligonucleotide or nanoparticles labeled with fluorescent marker, par. 178).

With respect to claims 36-38, Mirkin et al. teach further molecules bound to the bound molecules (par. 323) and the microstructure consisting of a single (par. 104) or several nanoparticles layers (par. 83).

Regarding claims 39 and 40, Mirkin et al. teach that within several microstructures, the nanoparticles making up the microstructures have different molecule specific recognition sites that are arranged on the carrier surface and various molecules are bound to the microstructures (different nucleic acids, par. 173).

2. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mirkin et al. (US 2002/0127574) in view of Kotov (US 7,045,087) further in view of Lynn et al. (US 7,112,361) and further in view of Mirkin et al. (US 2002/0132371).

Mirkin et al. ('574) in view of Kotov further in view of Lynn et al. teach the biologically active molecules are nucleic acids, but fail to teach them being antibodies.

Mirkin et al. ('371) teach that nucleic acids, antibodies and other specific protein binding proteins (col. 175) may be used in a similar device to provide for detection or protein analytes.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include in the function element of Mirkin et al. ('574) in view of Kotov further in view of Lynn et al., proteins instead of nucleic acids as taught by Mirkin et al. ('371), depending on whether detection of a protein analyte is detected.

Response to Arguments

3. Applicant's arguments filed 29 January 2010 have been fully considered but they are not persuasive. Applicant argues that the reference Lynn et al. has a filing date of October 24, 2002, which is before the foreign priority date of the instant application, December 28, 2001.

4. Applicant's argument is not persuasive because the priority of Lynn et al. (US 7,112,361) dates back to the provisional application filed 25 October 2001, which is before the foreign priority date of the instant application. MPEP §901.4 states: "The 35 U.S.C. 102(e) date *>of a U.S. patent can be an earlier effective U.S. filing date. For example, the 35 U.S.C. 102(e) prior art date of a U.S. patent issued from< a nonprovisional application claiming the benefit of a prior provisional application (35 U.S.C. 111(b)) is the filing date of the provisional application >for subject matter that is disclosed in the provisional application<.".

Therefore, Lynn et al. is available as prior art under 35 USC 102(b) because the priority date of Lynn et al. is more than one year before the US priority date, 27 December 2002, of the instant application. MPEP §706 states: "If the application claims foreign priority under 35 U.S.C. 119(a)-(d) or 365(a) or (b), the effective filing date is the filing date of the U.S. application, unless situation (A) or (B) as set forth above applies. The filing date of the foreign priority document is not the effective filing date, although the filing date of the foreign priority document may be used to overcome certain references.

Conclusion

5. No claims are allowed.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELANIE YU whose telephone number is (571)272-2933. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Shibuya can be reached on (571) 272-0806. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melanie Yu/
Primary Examiner, Art Unit 1641